



Docket No. 1293.1210 *TFW*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Jang-hoon YOO, et al.

Serial No. 09/899,501

Group Art Unit: 2655

Confirmation No. 9910

Filed: July 6, 2001

Examiner: Nabil Z. Hindi

For: COMPATIBLE OPTICAL PICKUP DEVICE USING A SINGLE LIGHT SOURCE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed October 21, 2005, having a shortened period for response set to expire on November 21, 2005, the following remarks are provided.

I. Provisional Election of Claims

Applicants provisionally elect Species I, which is shown in FIG. 2. While the Examiner has not defined which claims are within or generic to Species I, it is respectfully submitted that claims 1-12, 15-31, and 34-37 are within or generic to Species I.

Moreover, the Examiner asserts on page 2 of the Office Action that that no claims are considered generic. However, it is respectfully submitted that at least claims 1-11, 15-22, 26-31, and 34-37 are generic to the Species I through III. Specifically, claims 1-11, 15-22, 26-31, and 34-37 are not limited to the type of optical path changers and/or the location of the photodetector relative to the light source, whereas FIGs. I, II, and III show examples of structures with different optical path changers and locations according to aspects of the invention. As such, it is respectfully requested that at least claims 1-11, 15-22, 26-31, and 34-37 are generic for the claims in Species I through III, and that independent claims 1, 16, 21, and 36 are generic to any depending corresponding claims included in the non-elected species.

II. Applicants Traverse the Requirement

On page 2 of the Office Action, the Examiner asserts that applicants must elect between species drawn to Fig. 2 (Species I), to FIG. 8 (Species II), and FIG. 9 (Species III). As noted in MPEP 806.04, "if [an] application contains claims directed to more than a *reasonable number of species*, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application." (italics added). As such, applicants are allowed to have a reasonable number of species included in a single application without restriction. Moreover, MPEP 811 notes that, where a first action on the merits has already been issued such as in the instant application, "[b]efore making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." Such a finding and evidence supporting the finding is required in order prevent piecemeal examination and for meaningful review to be provided under the Administrative Procedures Act, 5 U.S.C. §706. In re Zurko, 59 USPQ2d 1693 (Fed. Cir. 2001). Consistent with the requirements in MPEP 803 and 808, the Examiner needs to provide a rationale as to why an election is required or how, without the election, the Examiner is unduly burdened in comparison with the burden visited on the applicants in the extra delay and expense in obtaining protection for each Species.

The Examiner has not provided evidence that the Examiner will experience an undue burden in searching and examining the invention set forth in Species I through III, and has not presented evidence as to the changed circumstance which warrants an election of species after the first action on the merits. Specifically, the Examiner has not provided evidence that the existence of three species represents an unreasonable number of species to be searched, has not shown evidence of separate classification for the species, and has not provided a rationale as to why the invention is to be separated into Species I through III. As such, it is respectfully submitted that the Examiner has not presented sufficient evidence of a burden on the Examiner in examining Species I through III which is out of proportion with the delay and expense visited on the applicants in filing divisional applications to timely protect the invention recited in Species II and III so as to show an undue burden on the Examiner or an unreasonable number of species so as to also require an election between these species. Therefore, it is respectfully requested that the Examiner reconsider and withdraw the election.

III. Conclusion

Upon review of references involved in this field of technology, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial election requirement, all of the pending claims should be examined in the subject application. In view of the foregoing arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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